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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/366,896	08/04/1999	PAUL NORMAN BURGESS	42430-10030	3637

7590
Patent Docket Clerk
Jenner & Block, LLC
One IBM Plaza
Chicago, IL 60611

04/09/2003

EXAMINER

DEANE JR, WILLIAM J

ART UNIT	PAPER NUMBER
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2642

DATE MAILED: 04/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/366,896

Applicant(s)

BURGESS, PAUL NORMAN

Examiner

William J Deane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 January 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 19-26 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 19-26 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 5, 9 and 11 – 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,085,081 (Leskinen).

With respect to claims 1 and 9, Leskinen teaches the claimed device and method as shown at Col. 3, line 22 – Col. 4, line 9, see also the abstract and claim 1).

Note that the device is only for outgoing calls (Col. 3, lines 11 – 15 and Col. 4, lines 35 – 39).

With respect to claims 11 and 12, such is inherent from the above.

Therefore, Leskinen teaches the claimed device except explicitly teaching that the device inhibits incoming calls. However, it appears that such is contemplated as there is no discussion of incoming calls, but only discussions of outgoing calls as shown above. Therefore, such would have been obvious to one of ordinary skill in the art that having only a user ID and no telephone number would inhibit incoming calls.

Claim are rejected under 35 U.S.C. 103(a) as being unpatentable over Leskinen in view of U.S. Patent No. 5,722,067 (Fougnies et al.).

With respect to claim 2 - 4 and 6 - 8, Leskinen teaches the claimed device except for assigning a currently assigned telephone number with the communications device for billing using ANI.

Fougnies et al. teach using ANI for billing purposes to a predetermined or pre-selected number (see Abstract, Summary of the Invention and claims). There is no reason why the pre-selected number could not already be a currently assigned number e.g. an office or home number with a prepaid account. It would have been obvious to one of ordinary skill in the art to have provided the Leskinen device and method ANI for billing purposes to an assigned number as taught by Fougnies et al. as such would only entail the substitution of one smart card for another.

With respect to claim 3, one a number is associated with a telephone number it would have been obvious to one of ordinary skill to use the association for maintenance billing and etc.

With respect to claims 7 and 10, obviously once the account is canceled the pre-selected number would be reused. With respect to claim 10 note Col. 4, lines 13 – 18. It would have been obvious to have provided the Leskinen device and method with the ability to assign temporary numbers as taught by Fougnies et al. in order for the Leskinen device to receive a incoming calls.

Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Leskinen in view of Fukuzawa et al.

Leskinen teaches the claimed device except for the temporary assigning of unassigned telephone numbers in which the assigning of temporary numbers is initiated by a phone

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call. However, Fukuzawa et al. teach such limitations (see Abstract, Summary of Invention and Claim 1). It would have been obvious to one of ordinary skill in the art to have provided the Leskinen device and method with the ability to initiate usage of a temporary number via phone call as taught by Fukuzawa et al. in order to receive incoming calls.

With respect to claims 19 – 26 such claims would be rejected in a like manner to the claims above. The claims, 19 – 26, are only differentiated by claiming the assigning of a telephone number to a line rather than to a device. However, such would have been obvious to one of ordinary skill in the art in light of the Leskinen reference. With such things as dedicated lines, it would have been obvious to assign a telephone number to a line just like assigning it to a device.

Response to Arguments

Applicant's arguments with respect to claims 1- 12 and 19 - 26 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bill Deane whose telephone number is (703) 306-5838. In addition, facsimile transmissions should be directed to Bill Deane at facsimile number (703) 872-9314.

03APR03

WILLIAM J. DEANE, JR.
PATENT EXAMINER